



R E M A R K S

Prior to entry of this Amendment, Claims 1-3, 5-11, 13, 15-21, 23-27, and 29-33 were pending and rejected.

Upon entry of this Amendment, Claims 1-3, 5-11, 13, 15-21, 23-27, and 29-33 will be pending; Claims 1, 8, 9, 10, 17, 18, 19, 26, 32, 33 will be the only independent claims; and Claims 1, 19, and 26 will be amended.

A. CLAIM AMENDMENTS

No new matter has been added by any amendment.

1. Claim 1

Claim 1 has been amended to correct an obvious typographical error.

2. Claim 19

Claim 19 has been amended to remove the limitation provided in the previous Amendment in order to overcome the Examiner's prior Section 101 rejection. It had been asserted that Claims 19-33 were directed to non-statutory subject matter because “[c]laims to mental steps such as ‘generating’, ‘causing’, ‘reading’ and ‘outputting’ or algorithms per se are not statutory subject matter under 35 U.S.C. 101. See MPEP 2106 IV B 1(a).” [First Office Action mailed December 14, 2004, page 2]. In our previous Amendment, we traversed the rejection of Claims 19-33 but amended independent Claim 19 in order to overcome the Examiner's rejection of Claims 19 and its dependent Claims 20, 21, and 23-25 (Claim 22 was cancelled at the same time). We mistakenly stated that Claims 26-33 were affected by the amendment to Claim 19:

Further, as each of claims 20 – 33 include by reference each of the limitations of claim 19, the amendment to claim 19 effectively amends the scope of claims 20 – 33 such that these claims now also satisfy the Examiner's proposed test for statutory subject matter. Applicants note that the amendment to claim 19 has been made solely to expedite allowance of the pending claims.

[page 16]. This statement of effect was incorrect, as Claims 26, 32, and 33 were (and still are) independent, and Claims 27 and 29-31 depend from independent Claim 26. We regret this misstatement.

B. CLAIMS 19-21, 23-27, AND 29-33 ARE DIRECTED TO STATUTORY SUBJECT MATTER UNDER SECTION 101

In order to clarify the record, we submit that all of pending Claims 19-21, 23-27, and 29-33 were directed to statutory subject matter as they were pending prior to the previous Amendment. Accordingly, we have removed the limitation

on a display of an electronic device and via a processor of the electronic device from independent Claim 19 that was added solely in order to expedite allowance of the claims. We are not aware of any case law that would support the Examiner's "mental steps" or "algorithms per se" rejection. We also note that the USPTO has recently issued "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" which states that "mental step or human step tests" "are not to be applied by examiners in determining whether the claimed invention is patent eligible subject matter." [1300 OG 142, Annex III, "Improper Tests For Subject Matter Eligibility"]. The proper legal test for the presence of statutory subject matter is only that a claimed process or apparatus produce a "useful, concrete and tangible result." State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1375, 47 USPQ2d 1596, 1602 (Fed. Cir. 1998), cert. denied, 525 U.S. 1093, 142 L.Ed.2d 704, 119 S.Ct. 851 (1999); Interim Guidelines. Claim 19 is directed to a practical application—it produces various useful, concrete, and tangible results (e.g., a pattern of nodes in a play area, a determination of whether a player is eligible for a prize). The Examiner has never asserted that Claim 19 does not produce a useful, concrete, and tangible result.

Each of Claims 26, 27 and 29-33 is also directed to a practical application. The Examiner has never asserted otherwise.

C. SECTION 102(E)/SECTION 103(A) REJECTIONS

Claims 1-3, 5-11, 13, 15-21, 23-27, and 29-33 are rejected under Section 102(e) or in the alternative under Section 103(a), in light of assertions allegedly supported by Riendeau (U.S. Patent No. 6,761,633).

Claim 12 is rejected under Section 103(a) in light of Riendeau and Sultan (U.S. Patent No. 6,273,817). The Examiner has failed to establish a prima facie case of obviousness (or anticipation, which is the epitome of obviousness) for any pending claim.

1. Applicable Law

1.01. **Prima facie burden**

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D 1443, 1444 (Fed. Cir. 1992).

1.02. Claim interpretation must be consistent with the specification

During examination, claims are given their broadest reasonable interpretation that those skilled in the art would reach, consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D 1664, 1667 (Fed. Cir. 2000); In re Cortright, 165 F.3d 1353, 1359, 49 U.S.P.Q.2D 1464, 1468 (Fed. Cir. 1999).

1.03. Substantial evidence required for all factual findings

The Board is not permitted to accept conclusory, unsupported findings made by the Primary Examiner that are not supported by substantial evidence made of record.

All findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. In re Gartside, 203 F.3d 1305, 1315, 53 U.S.P.Q.2D 1769, 1775 (Fed. Cir. 2000).

The Supreme Court has described “substantial evidence” in the following manner:

substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence.

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); see also, Dickinson v. Zurko, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 1935, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) (“Zurko III”).

“[R]eview under this standard involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the agency’s decision.” Universal Camera Corp. v. NLRB, 340 U.S. 474, 487-88, 95 L. Ed. 456, 71 S. Ct. 456 (1951); Zurko III, 527 U.S. at 162.

2. Independent Claims 1, 8, 9, 10, 17, 18, and 19

Claim 1 includes a feature of

- *further wherein any one of the play symbols is selectable at the start of a game of the lottery ticket*

Claims 8 and 9 incorporate by reference the above limitation of Claim 1.

Claims 10 and 19 include a feature of

- *further wherein any one of the nodes is selectable at the start of a game of the lottery ticket*

Claims 17 and 18 incorporate by reference the above limitation of Claim 10.

The Examiner does not address either of the above features and we could not identify an explanation in the Office Action for how the Examiner has interpreted Riendeau as teaching or suggesting these features. We respectfully request an explanation of how the Examiner is interpreting the claim language and Riendeau, in order to clarify the record and to assist us in responding to the rejection.

It appears to us that Riendeau suggests that not any one of the play symbols or nodes is selectable at the start of the games in Riendeau. As explained in Riendeau, a player must make a first selection at the start of the game from one of designated “nodes”—not any one of the depicted “nodes” or points in the play area may be selected at the start of the game. A player could not, for example, first select a “finishing point” in Riendeau or some other mid-point in the displayed branches. [See, e.g., Abstract (“as play progresses between a starting point and multiple finishing points”); FIG. 1, FIGs. 2A-2B (“START” 52); Column 7, lines 1-4 (“According to a sample game, the player’s current position is marked using a marker (herein depicted as a star) at a starting point 52 (see FIG. 2A). From there the player must choose between a first branch 62 and a second branch 64.”) (emphasis added)].

Sultan does not suggest the above features; the Examiner does not assert otherwise.

The Examiner has not established with substantial evidence that all of the features of independent Claims 1, 8-10, 17, 18, or 19 were known or desirable. Accordingly, the Examiner has not established a prima facie case of obviousness for Claims 1 (and its dependent Claims 2, 3, and 5-7), 8, 9, 10 (and its dependent Claims 11-13, 15, and 16), 17, 18, and 19 (and its dependent Claims 20, 21, and 23-25). We respectfully request that the Examiner withdraw the Section 102(e)/103(a) rejection of Claims 1-3, 5-13, 15-21, and 23-25.

3. Claims 2 and 11

We disagree with the Examiner’s assertion: “As to claims 2 and 11, the numbers with the negative signs, such as 76, are considered ‘void’ and are a ‘non-continuous path’ in that they need to be ‘bypassed’ or cause negative points.” [page 2]. We do understand the Examiner’s reasoning, and request further explanation. We do not agree that “negative points” are “void symbols.” It also appears to us that Riendeau does not suggest that “negative points” is a “void symbol” that causes a path to be a non-continuous path. To the contrary, it is clear that a player playing the Riendeau game continues along a path even if the revealed number is negative (i.e., a prize decrement). The alleged (and unsupported) need to “bypass” a node that would result in a prize decrement does not suggest that the existence of “negative points” causes non-continuity of any

path. We respectfully request the Examiner withdraw the Section 102(e)/103(a) rejection of Claims 2 and 11.

4. Claims 26, 27, and 29-33

Although we do not necessarily agree with the Examiner's rejection of independent Claims 26, 32, and 33, independent Claim 26 is now amended to provide for a feature of

- *wherein any one of the nodes is selectable at the start of a game of the simulated scratch-off lottery ticket*

Independent Claims 32 and 33 will incorporate the above feature by reference to Claim 26. For the reasons stated above with respect to Claims 10 and 19, we submit that Riendeau does not teach or suggest selecting any node of a pattern of nodes spanning a play area at the start of a game. Accordingly, we respectfully request that the Examiner withdraw the Section 102(e)/103(a) rejection of Claims 26 (and its dependent Claims 27 and 29-31), 32, and 33.

5. Additional Comments

Our silence with respect to the Examiner's other various assertions, including assertions of what Riendeau and Sultan teach or suggest, of what is "inherent" in Riendeau, of what would have been obvious in light of Riendeau and/or Sultan, and of what would have been "well known" or "obvious" to do, is not to be understood as agreement with the Examiner. As the Examiner has not established an unrebuttable *prima facie* case of obviousness for any of the pending claims, for the reasons stated above, we need not address the Examiner's other assertions at this time.

D. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date



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